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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,050	03/22/2004	James E. Kipp	IFT-6019	1570

7590 10/31/2007  
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EXAMINER
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KUGEL, TIMOTHY J

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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10/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/806,050

Applicant(s)

KIPP ET AL.

Examiner

Timothy J. Kugel

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-7,9-14 and 16-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,16,17 and 22-25 is/are allowed.
- 6) ☒ Claim(s) 1,5-7,9-14,18-21 and 26-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1, 2, 5-7, 9-14 and 16-28 are pending as amended on 17 October 2007, claims 3, 4, 8 and 15 being cancelled.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 October 2007 has been entered.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Response to Amendment and Arguments***

4. Applicant's amendment to claim 16, filed 17 October 2007, specifically addressing the objection of the previous Office action has been fully considered and overcomes the following:

The objection to claim 16 because of informalities has been withdrawn.

5. Applicant's amendment to independent claims 2 and 5 and argument regarding claim 1, filed 17 October 2007, specifically addressing the indefiniteness of the claims, have been fully considered and overcomes the following:

The objection to claims 1, 2, 5, 6, 9-14, 16-19 and 22-26 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn.

6. Applicant's amendment to independent claim 1, although unsupported by the original specification or claims (see below), filed 17 October 2007, specifically requiring the two streams to mix outside the chamber of the comminuting apparatus, has been fully considered and overcomes the following:

The rejection of claims 1 and 9-11 under 35 USC 102(b) as being anticipated by Midler has been withdrawn, but will be reinstated if the unsupported limitation is removed in response to the rejection under 35 USC 112, first paragraph cited below.

7. Applicant's further arguments, filed 17 October 2007, have been fully considered but they are not persuasive.

Applicant argues that US Patent 5,314,506 (Midler hereinafter) fails to teach or suggest mixing the two streams outside the chamber of the apparatus. This may be so, but independent claims 5 and 7 fail to require this limitation, and further the original disclosure and/or claims fail support such a limitation (see below).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1 and 9-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Independent claim 1 recites the limitation wherein the mixing of the first solution with a second solvent takes place “outside of said chamber of said comminuting apparatus;” however, such limitation fails to find support in the original disclosure or claims. This is a new matter situation.

***Claim Rejections - 35 USC § 102***

9. Claims 5, 7, 18-21 and 26-28 stand rejected under 35 USC 102(b) as being anticipated by Midler.

Midler teaches a method of producing a particle suspension comprising impinging jets of a solution of an organic compound in an organic solvent and an anti-solvent—including water—such that a high purity stable dispersion results (Column 2 Lines 16-19, Column 4 Line 55 – Column 5 Line 19 and Figures 2 and 3). Midler also

teaches that the fluids of the process can contain a surfactant (Column 5 Lines 32-45) and that the fluids can be cooled with an ice bath (Example 2 Column 8 Line 55 – Column 9 Line 16). Midler shows that the fluid streams would impact on the flat and/or semi-spherical surfaces on both sides of the chamber and be re-directed in the substantially opposite direction as they enter the chamber (Figures 2 and 3). Further, Midler shows that the streams do not need to be directly impinging (Figure 2).

### ***Claim Rejections - 35 USC § 103***

10. Claim 6 stands rejected under 35 USC § 103(a) as being unpatentable over Midler as applied to claims 5, 7, 18-21 and 26-28 above in view of US Patent 3,685,261 (McIlvaine).

As detailed above, Midler teaches a method of producing a particle suspension comprising impinging jets of a solution of an organic compound in an organic solvent and an anti-solvent—including water—such that a high purity stable dispersion results. Midler also teaches that the fluids of the process can contain a surfactant and that the fluids can be cooled with an ice bath. Midler shows that the fluid streams would impact on the flat and/or semi-spherical surfaces on both sides of the chamber and be re-directed in the substantially opposite direction as they enter the chamber. Further, Midler shows that the streams do not need to be directly impinging.

Midler does not disclose expressly the use of the Venturi effect to combine the two fluid streams.

Mcllvaine discloses a method and apparatus for dispersing two fluids including a Venturi (Column 1 Line 56 – Column 2 Line 15 and Figures 1-6).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Venturi of the apparatus of Mcllvaine in the method of Midler. The motivation to do so would have been to thoroughly mix and disperse the two fluids (Mcllvaine Column 2 Lines 13-15).

#### ***Allowable Subject Matter***

11. Claims 2 and 22-24 are allowed for the reason of record.

#### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached 6:00 AM – 4:30 PM Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

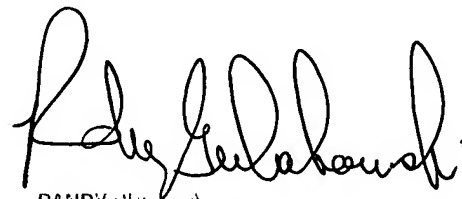
For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

/TJK/

Patent Examiner, AU 1796

A handwritten signature in black ink, appearing to read "Randy Gulakovets", written in a cursive style.

RANDY GULAKOVETS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700